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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/942,635 | 08/30/2001 | Steven Harold Cary | AUS9-2001-0646-US1 | 9077 |

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| EXAMINER | |
|---|---|
| CHOI, PETER H | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3623 | |

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/942,635 | CARY ET AL. | |
| | Examiner | Art Unit | |
| | Peter Choi | 3623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. The following is a **non-final** office action upon examination of application number 09/942,635. Claims 1-20 are pending in the application and have been examined on the merits discussed below.

### *Response to Amendment*

2. Claims 1-2, 4-9, and 11-20 have been amended; no claims have been canceled or added.

### *Drawings*

3. The drawings were received on March 29, 2006. These drawings are acceptable.

### *Specification*

4. The objections to the specification are withdrawn in view of Applicant's amendments to the specification received on March 29, 2006.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for assessing the accuracy of a sample of household data, does not reasonably provide enablement for "comparing" or "matching" sample household records to reference file records in order to determine the "balance" of sample data or calculate a "bias value" of sample records. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The unclear scope of the claimed invention does not enable practice by those that are old and well known in the art. The claimed invention presents a plurality of

broad means of assessing the accuracy of demographic data. The disclosure of the claimed invention would not enable the use of the claimed invention, for the reasons presented below.

The scope of the claimed "reference file" is unclear. Is said reference file a collection of definitive and benchmarked values (i.e., data for the population, as opposed to a sample of the population) , or merely existing data from within a database?

The recitation of generic, unidentified comparison means to evaluate whether the data source is "balanced" does not convey the specifics of what the comparison means encompasses. Further, the criterion by which the data source is deemed as "balanced" is vague and generic, as it is only tied to the comparison of each record in the sample quantity of records to a reference file. The degree to which data is considered to be "balanced" has not been set forth. How does the comparison of sample data to a reference file establish that said sample represents the data source? By definition, a data sample from a collection of data is "representative" of the data collection, as samples are merely a portion, piece or segment that is representative of the whole. In lieu of specific criterion for determining whether data is "balanced", the practice of the claimed invention would vary greatly depending on the person practicing the invention.

Similarly, the claimed invention provides for the generation of a comparison master file, based on a matching of records from a sample quantity to a reference file, but does not convey the specifics of the methodology used in said matching step. The degree to which data is considered to be a "match" has not been set forth. For example, does data have to be verbatim in order to "match", or be similar in part (i.e., a predetermined percentage/number of data fields are the same)? In lieu of specific criterion for the definition of "matching", the practice of the claimed invention would vary greatly depending on the person practicing the invention.

Without a basis to ascertain whether sample data "matches" reference file data, one of ordinary skill in the art would not be enabled to calculate a bias value. No quantifiable measure of the sample or reference data has been established; thus, it is unclear how a user of the claimed invention would be enabled to perform any calculations. Furthermore, the claimed bias values are calculated based upon the matching of sample records with the reference records, but are meaningless, as they are not presented in a context in which they are used in order to effect a decision regarding the quality of the data sample, and thus are not deemed to have any useful result. In lieu of specific criterion for the definition of "matching", the resulting bias values calculated would thereby also lack usefulness, further render the practice of the claimed invention dependent on the person practicing the invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The term "approximates" in claims 3, 10, and 17 is a relative term that renders the claim indefinite. The term "approximates" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a

result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)*). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson, 409 U.S. at 71-72, 175 USPQ at 676-77*).

Regarding a useful result, the claimed invention does not yield a result that is specific, substantial and credible. The recitation of generic, unidentified comparison means to evaluate whether the data source is "balanced" is not deemed to be specific, substantial, and credible because the claimed invention does not convey the specifics of what the comparison means encompasses. Further, the criterion by which a data source is deemed as "balanced" is vague and generic, as it is only tied to the comparison of each record in the sample quantity of records to a reference file. Similarly, the generation of a comparison master file based on a matching of records from a sample quantity to a reference file does not convey the specifics of the methodology used in said matching step. The bias values are calculated based upon the matching of sample records with the reference records, but are not presented as being used in order to effect a decision regarding the quality of the data sample, and thus are not deemed to have any useful result. In lieu of specific criterion for the definition of "matching", the resulting bias values calculated would thereby also lack

usefulness, further render the practice of the claimed invention dependent on the person practicing the invention.

Regarding a concrete result, the claimed invention does not yield a result that is substantially repeatable. As mentioned above, the claimed invention does not convey the specifics of the comparison of data, or criterion for evaluation whether the sample data is "balanced", "matches" or "approximates" reference data. In lieu of specific criterion for these steps, the practice of the claimed invention would vary greatly depending on the person practicing the invention. Human judgment is significantly affected by one's personal and unique experiences. The claimed invention lacks concreteness since the practice of the invention is solely dependent on subjectivity of a human user, which varies form person to person. In other words, the outcome of the practice of the claimed invention is not substantially repeatable, since the claimed invention is dependent on factors that could yield a significantly altered result every time use of the invention is repeated.

Regarding a tangible result, the claimed invention must set forth a practical invention that generates a real world result, i.e., the claim must be more than a mere abstraction. The claimed invention of assessing the accuracy of demographic (household) data is deemed to be non-statutory for at least failing to produce a tangible result. The claimed invention could be limited to the mind of a human user. Until such steps are used to manifest some effect in the real world, they constitute a mere abstract

idea. If, however, the method and system of the claimed invention were used to effect the decision to purchase demographic/household data from third party data vendors, as presented in the specification, or to make a decision whether to incorporate sample data within an existing database of demographic data, then the claimed invention would be deemed to generate a real-world and tangible result.

The household data recited in claims 1-20 are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the type of data. Further, the structural elements remain the same regardless of the type of data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ∋ 2106.*

Because claims 1-20 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Neal et al. (U.S Patent #6,631,365) teaches a method and apparatus for analyzing the quality of the contents of a database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peter Choi
Examiner
Art Unit 3623

June 12, 2006

Susanne Diaz
Susanne Diaz
Primary Examiner
AU 3623